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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,057	01/22/2001	Ursula Murschall	00/050 MFE	8999
7590	11/26/2003			
ProPat, L.L.C. 2912 Crosby Road Charlotte, NC 28211				
			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT 1774	PAPER NUMBER

DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/767,057

Applicant(s)

MURSCHALL ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed September 25, 2003.

Claims 1 was amended and claim 2 was canceled rendering claims 1 and 3-16 pending.

### ***New Matter - 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 and 3-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In instant claim 1, the phrase 'a polyolefin-free crystallizable thermoplastic' is not supported by the specification.

### ***Claim Objection***

4. Instant claim 1 is amended to include 'a polyolefin-free crystallizable thermoplastic which has been selected from the group consisting of polyethylene terephthalate, polybutylene terephthalate, and polyethylene naphthalate.' This

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amendment is objected to because according to the McGraw-Hill Dictionary of Chemical Terms a polyolefin is a polyethylene. It is unclear how claim 1 can be polyolefin-free and simultaneously comprise polyethylene and polybutylene material, which are defined as polyolefins. Furthermore, Kim et al. defines polyolefin resins as polyethylene and polypropylene (column 2, lines 10-12).

***Claim Rejections – 35 USC § 103(a)***

5. Claims 1, 3-7 and 12-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Srinivasan (U.S. 6,309,987) for reasons previously stated in the Office Action submitted on February 12, 2003. Regarding the newly added limitation to claim 1, 'a polyolefin-free crystallizable thermoplastic which has been selected from the group consisting of polyethylene terephthalate, polybutylene terephthalate, and polyethylene naphthalate,' Kim shows a white film comprising polyethylene terephthalate (crystallizable thermoplastic) (column 1, line 58 through column 2, lines 12).

***Claim Rejections – 35 USC § 103(a)***

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Srinivasan (U.S. 6,309,987) further in view of Tono et al.

(U.S. 6,410,122) for reasons previously stated in the Office Action submitted on February 12, 2003.

***Claim Rejections – 35 USC § 103(a)***

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Srinivasan (U.S. 6,309,987) further in view of von Meer (U.S. 5,660,931) for reasons previously stated in the Office Action submitted on February 12, 2003.

***Claim Rejections – 35 USC § 103(a)***

8. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Srinivasan (U.S. 6,309,987) further in view of Yamazaki (U.S. 6,106,924) for reasons previously stated in the Office Action submitted on February 12, 2003.

***Response to Arguments***

9. Applicants arguments of rejection under 35 USC 103(a) as being unpatentable over Kim et al. (U.S. 5,660,931) in view of Srinivasan (U.S. 6,309,987) have been considered but are unpersuasive. Applicant states claim 1 has been amended to further include the film is "polyolefin-free", where it is evident that Applicant's film does not contain any polyolefins.

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Additionally, in instant claim 1, the phrase 'a polyolefin-free crystallizable thermoplastic' is not supported by the specification. This amendment is objected to because according to the McGraw-Hill Dictionary of Chemical Terms a polyolefin is a polyethylene. It is unclear how claim 1 can be polyolefin-free and simultaneously comprise polyethylene and polybutylene material, which are defined as polyolefins. Furthermore, Kim et al. defines polyolefin resins as polyethylene and polypropylene (column 2, lines 10-12). Applicant states the claims have been amended to define the thermoplastic as polyester.

Examiner respectfully disagrees because claim 1 was amended to define the thermoplastic as polyethylene terephthalate, polybutylene terephthalate, and polyethylene naphthalate and not polyester. Applicant argues the combination of Kim and Srinivasan is improper because Kim describes a blend or mixture of a polyester and polyolefin to make synthetic paper and Kim cannot be modified by eliminating the polyolefin. Examiner maintains that Kim is not being modified by eliminating polyolefin; however, because Kim et al. defines the polyolefin as polyethylene, Kim et al. meets Applicant's instantly claim limitation of a crystallizable thermoplastic being selected from the group of polyethylene terephthalate. Applicant argues the instantly claimed film does not contain polyolefin; however polyethylene is defined as a polyolefin.

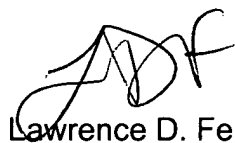
### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM

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– 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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